

REMARKS

I. Introduction

With the cancellation of claim 38, without prejudice, claims 1 to 37 are pending in the present application. In view of the preceding amendments and following remarks, applicants respectfully request reconsideration of the present application.

II. Rejection of Claims 18 to 20 Under 35 U.S.C. §102(b)

Claims 18 to 20 were rejected as anticipated by United States Patent No. 5,967,336 ("Baltzer et al."). Applicants respectfully submit that Baltzer et al. do not anticipate claims 18 to 20 for the following reasons.

Claim 18 relates to a screen assembly. Claim 18 recites the features of a frame, spaced side end members on said frame, ends of said side members, first and second spaced end members at said frame at said ends of said side members, openings between said side members and said first and second end members, a screen on said frame overlying said openings, a plurality of spaced ribs extending between and joining said spaced side members, upper edges on said ribs, and lower concave edges on said ribs.

Baltzer et al. allegedly relate to a vibrating screen assembly with improved frame. Title. The Office Action alleges that Baltzer et al. provide a frame 12 with spaced side members 14, 16 and first and second spaced end members 18, 20. The Office Action states that Baltzer et al. also provide a plurality of spaced ribs extending between and joining said spaced side members (elements 40, 42, 44, 46, 48 and 50).

Applicants respectfully submit that claim 18 requires the feature of a plurality of spaced ribs extending between and joining said spaced side members. Applicants respectfully further submit that these spaced ribs are required to have upper edges and lower concave edges. As evidenced from elements 48 and 50, See Fig. 7 for example, the alleged ribs do not have any lower concave edges on said ribs. Elements 40, 42, 44, 46, 48 and 50 are disclosed as box members, different than the necessary lower concave edges. The specification at col. 4, lines 27 to 30 disclose that the supports are tubular shapes. Baltzer et al. do not disclose

or suggest any configuration wherein the lower concave edges are on the ribs and therefore Baltzer et al. do not anticipate independent claim 18.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the references relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejections must necessarily fail for the foregoing reasons.

Claims 19 and 20 depend from claim 18 and therefore include all the features of independent claim 18. Applicants respectfully submit that claims 19 and 20 are patentable for at least the reasons presented in conjunction with independent claim 18.

III. Rejection of Claims 34 to 37 Under 35 U.S.C. §102(b)

Claims 34 to 37 were rejected as anticipated by United States Patent No. 6,269,954 ("Baltzer"). Applicants respectfully submit that Baltzer does not anticipate claims 34 to 37 for the following reasons.

The Office Action admits that claim 38 is objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As a result, claim 38 contains patentable subject matter. Applicants have amended independent claim 34 with the patentable subject matter contained in allowable claim 38. Applicants respectfully request withdrawal of the rejection to claims 34 to 37.

IV. Rejection of Claims 18 and 21 Under 35 U.S.C. §103(a)

Claims 18 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 4,473,466 ("Schmidt et al. ") in view of United States Patent No. 5,927,511("Riddle et al."). Applicants respectfully submit that claims 18 and 21 are patentable for the following reasons.

Claim 18 relates to a screen assembly. Claim 18 recites the features of a frame, spaced side end members on said frame, ends of said side members, first and second spaced end members at said frame at said ends of said side members, openings between said side members and said first and second end members, a screen on said frame overlying said openings, a plurality of spaced ribs extending between and joining said spaced side members, upper edges on said ribs, and lower concave edges on said ribs.

Schmidt et al. allegedly relate to a flat sieve element. Title. The element 1 has parallel ribs 8 which together with two frame sides define slots 3. Col. 2, lines 17 to 22. The Office Action alleges that element 6 is "a plurality of spaced ribs". Figure 2 illustrates the element 6 is a member that is vertically oriented with sharp edges on both the upper and lower faces. Element 6 does not disclose or even suggest any configuration which has lower concave edges.

The addition of the Riddle et al. reference does not cure the defects of the Schmidt et al. reference. The Riddle et al. reference allegedly provides a flat screen panel for a crowned deck vibrating shaker. Title. As illustrated in Figure 3, the braces 60, 62 and 64 extending across the width and length of the panel are round rods and rectangular bars. The Riddle et al. reference does not disclose or

suggest any configuration wherein a plurality of spaced ribs extends between and joining said spaced side members, upper edges on said ribs, and lower concave edges on said ribs.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Applicants respectfully submit that the references cited herein do not meet this standard.

It is respectfully submitted that the cases of *In re Fine*, *supra*, and *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of *In re Fine* stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of *In re Jones* stated that: Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of *In re Kotzab* has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner*

claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Applicants respectfully submit that the combination of Schmidt et al. and Riddle et al. do not render obvious claim 18 and claim 21 which depend from claim 18.

IV. Rejection of Claims 22 to 33 Under 35 U.S.C. §103(a)

Claims 22 to 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baltzer et al. in view of United States Patent No. 5,417,859 ("Bakula ") in view of Baltzer. Applicants respectfully submit that claims 22 to 33 are patentable for the following reasons.

Independent claim 22 relates to a screen assembly. Claim 22 recites a frame, first and second side members on said frame, ends on said side members, upper and lower surfaces on said side members, first and second spaced end members on said frame at said ends of said side members, a plurality of spaced ribs extending between and joining said spaced side members, openings between said side members and said end members, an undulating screen on said frame overlying said openings, said end members including upper end member surfaces and lower end member surfaces, and a lip on said lower end member surface of said first end member. Claim 22 has been amended without prejudice herein to recite that the ribs are tapered away from said screen. Support for the amendment to claim 22 is found, for example, in original claim 38.

Baltzer et al. allegedly relate to a vibrating screen assembly with improved frame. Title. The Office Action alleges that Baltzer et al. provide a frame 12 with spaced side members 14, 16. and first and second spaced end members 18, 20. The Office Action states that Baltzer et al. also provide a plurality of spaced ribs extending between and joining said spaced side members (elements 40, 42, 44, 46, 48 and 50).

Applicants respectfully submit that claim 22 requires the feature wherein said ribs are tapered away from said screen. As evidenced from elements 48 and 50,

See Fig. 7 for example, the alleged ribs are tapered away from the screen. Elements 40, 42, 44, 46, 48 and 50 are disclosed as box members.

The addition of Bakula does not cure the defects of the Baltzer et al. reference. As illustrated in Bakula figures 1 to 27 and described in the Bakula specification, Bakula lacks any disclosure or suggestion of ribs that are tapered away from the screen.

The addition of Baltzer does not cure the defects of the Baltzer et al. and Bakula references. Baltzer provides a complex shaped channel 46 as illustrated in Figure 6 and does not provide the features required in claim 22. Applicants respectfully submit that Baltzer does not disclose or suggest the features of ribs that are tapered away from said screen.

Claims 23 to 33 depend from claim 22 and therefore include the features of amended claim 22. Claims 23 to 33 are patentable for at least the same reasons presented above in relation to claim 22.

V. Allowable Claims

Applicants note that claims 1 to 17 are allowed as indicated on page 5 of the June 17, 2005 Office Action.

VI. Conclusion

It is respectfully submitted that all pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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Dated: 9/15/05

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